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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,406	02/20/2004	Shlomo Ruvane Frieman		6344

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EXAMINER

COLLINS, DOLORES R

ART UNIT PAPER NUMBER

3711

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/783,406

Applicant(s)

FRIEMAN, SHLOMO RUVANE

Examiner

Dolores R. Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 40-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 40-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

Examiner acknowledges response by applicant's representative received 3/24/06.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 & 40-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morales (091).

Regarding claims 1-3 & 40-48

Morales discloses Integer Cards. Morales teaches a deck with multiple sets of playing cards (see abstract). Each set comprising $2M+1$ playing cards with a range $-M$ to M (see figure 1). Morales fails to teach that M being greater than 6. Morales however teaches that his cards are used as a tool by teachers in maintaining the

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interest of students (see col. 4, lines 20-24) and further teaches that modifications may be made without exceeding the scope of his invention (see col. 4, lines 26-34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Morales to include integers of at least 10 to stimulate interest and add an additional challenge for the students. The actual integer is merely the contents of the card, which is directed to printed matter. See infra. ~~ex~~

Morales further fails to teach the specific arrangement and/or content of indicia, set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use any type of numerals since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of numerals does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate, which is required for patentability.

Response to Arguments

Applicant's arguments filed 3/24/06 have once again been fully considered but they are not persuasive. Applicant has argued examiner's use of *In re Gulack* but all that applicant has claimed is indicia.

Applicant argues that the office action's reliance on *In re Gulack* is misplaced since it fails to address the functional relationship between the substrate and the printed matter thereon. Examiner disagrees with this contention. Applicant has apparatus claims with limitations of indicia only. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate, which is required for patentability. Applicant needs to define over the applied prior art of reference with structure rather than function. See *In re Schreiber*, 128 F 3d 1473 (Fed cir 1997). Applicant is arguing the value of the indicia on the cards, which are merely printed matter. Therefore, the examiner maintains the application of *In re Gulack*.

Applicant argues that based on *In re Miller*, his printed matter conveys information (rank and value). Examiner fails to find novelty in the rank and value of any playing card, particularly where obvious functionality is absent from the claims. Examiner reiterates that applicant's claims are apparatus claims and not apparatus combined with a method of play or use.

Examiner feels that applicant has improperly used paper currency to demonstrate his position. Currency by definition (Webster) is something that is

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circulation as a medium of exchange. It is known/defined as an article for bartering.

The numbers/indicia printed on paper currency are functional. Replacement of such numbers with letters would fail the test of reliance on *In re Gulack* because the numbers are functional to the bartering process. Applicant is claiming a deck of playing cards. Cards by definition (Webster) are a set of rectangular pieces made of paperboard or plastic marked on one side to show rank and value and used to play any of numerous games. Unless applicant claims the function of his indicia, they will be considered printed matter. Unless applicant claims the functionality of the size of his deck, such will be considered mere duplication.

Regarding applicant's argument regarding the use of only two sets of cards, applicant's claim does not disclose using "only two sets of cards exclusively." Furthermore, dependent claims 2 & 3 disclose M having separate values. Examiner interprets each of the sets (a first and a second) having a value of $M = 12$ and each set (a first and a second) having a value $M = 13$. This interpretation lends to the concept of four different sets. Given that two sets are exclusively claimed, Morales shows two sets as claimed.

Regarding applicant's arguments regarding M being equal to 12 or 13 in claims 2 & 3, as previously stated, applicant needs to define over the applied prior art of reference with structure rather than function.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited to show the state of art with respect to features of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Dolores R. Collins** whose telephone number is **(571) 272-4421**. The examiner can normally be reached on 8.00 A.M. - 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Eugene Kim** can be reached on **(571) 272-4463**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).



4/17/06



EUGENE KIM
SUPERVISORY PATENT EXAMINER